

## **REMARKS**

### **REVIEW**

The current application sets forth claims 1-24 of which claims 1, 10 and 24 are independent claims. Presently, no claims have been indicated as allowed in view of the prior art.

The drawings stand objected to for the repeated use of reference number “22” to indicate more than one element of the invention in Figure 1. Claims 10, 15, 16, and 18 stand collectively rejected under 35 U.S.C. § 102(b) as being anticipated by Jio (U.S. Patent No. 5,179,768). Claims 10, 15, 17, and 18 stand collectively rejected under 35 U.S.C. § 102(b) as being anticipated by Hatayan (U.S. Patent No. 4,079,765). Claims 10 and 21 stand collectively rejected under 35 U.S.C. § 102(b) as being anticipated by Posey (U.S. Patent No. 3,130,463).

Additionally, claims 1, 2, 4, 5, 7-9, 12, and 13 stand collectively rejected under 35 U.S.C. § 103(a) as being unpatentable over Jio in view of Bass (U.S. Patent No. 6,264,335). Claims 1, 2, 4, 6, 9, 12, and 13 stand collectively rejected under 35 U.S.C. § 103(a) as being unpatentable over Hatayan in view of Bass. Claims 3, 14, and 20 stand collectively rejected under 35 U.S.C. § 103(a) as being unpatentable over Jio in view of Beebe (U.S. Patent No. 5,669,327). Claims 11 and 19 stand collectively rejected under 35 U.S.C. § 103(a) as being unpatentable over Jio in view of Ryder (U.S. Patent No. 3,685,482). Claims 22 and 23 stand collectively rejected under 35 U.S.C. § 103(a) as being unpatentable over Posey in view of Beebe. Finally, claims 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Jio and Bass in view of Ryder.

**DRAWING OBJECTION**

It is respectfully submitted that the present objection to Figure 1 is moot in light of the proposed changes thereto in the attached Replacement Sheet encompassing Figures 1 and 2. In Figure 1, the lower extension arm was inadvertently referenced twice, by both the proper reference number “24” (on the left of the figure) and again as “22” (at the far right of the figure). To overcome the present objection and avoid any potential misinterpretation of which element is referenced by the offending reference number “22” it has been removed in the attached Replacement Sheet.

**35 U.S.C. § 102(b) REJECTIONS****Claims 10, 15, 16, and 18 as anticipated by Jio**

With respect to the 35 U.S.C. § 102(b) rejection of claim 10, 15, 16, and 18, and in view of the significant distinctions discussed herein, Applicants respectfully traverse such ground of rejection with the above amendments and the following remarks. As discussed in more detail below, each of the independent claims of the present invention encompasses certain common aspects that distinguish it from the proposed base references in all of the proposed 102(b) rejections. It is, thus, respectfully submitted that the reference, Jio, merely serves to demonstrate the patentability of Applicant’s claimed invention. Specifically, Jio fails to adequately disclose every element of the claimed invention and as such cannot serve at law as an anticipating reference to the present invention under 35 U.S.C. § 102.

Before setting forth a discussion of the prior art applied in the Office Action, it is respectfully submitted that controlling case law has frequently addressed rejections under 35 U.S.C. § 102. "For a prior art reference to anticipate in terms of 35 U.S.C. Section 102, **every element** of the claimed invention **must** be **identically** shown in a single reference." Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 677, 7 U.S.P.Q.2d 1315, 1317 (Fed. Cir. 1988; emphasis added). The disclosed elements must be arranged as in the claim under review. See Lindemann Machinefabrik v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). If any claim, element, or step is absent from the reference that is being relied upon, there is **no** anticipation. Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986; emphasis added). The following analysis of the present rejection is respectfully offered with guidance from the foregoing controlling case law decisions.

Specifically, independent claims 1, 10, and 24 each specify that the present invention is a path marking apparatus for use by those traveling through heavily wooded or other overgrown areas to enable them to retrace their steps for a safe return to their point of origin. Further, each independent claim specifies the adherence of a light-reflective tape-like sticker to at least one of the outer surfaces of the apparatus.

It is respectfully submitted that the presently proposed base reference Jio fails to adequately disclose such element and as such cannot serve as a basis for the rejection of any of claims 10, 15, 16, or 18 under 35 U.S.C. § 102. Still further, none of the proposed secondary references presently cited in the 35 U.S.C. § 103(a) rejections serve to overcome this deficit. As such, it is believed and respectfully submitted that the present § 102(b) rejection of claims 10, 15, 16, and 18 is moot. It is

further submitted that such claims are in condition for allowance and acknowledgement of the same is earnestly solicited.

**Claims 10, 15, 17, and 18 as anticipated by Hatayan**

As discussed above in more detail, it is respectfully submitted that the present § 102(b) rejection of claims 10, 15, 17, and 18 is moot in light of the above amendments and comments. Specifically, the proposed reference, Hatayan, fails to disclose each and every element of the claimed invention in independent claim 10. As claims 15, 17, and 18 depend from and further limit claim 10, it is respectfully submitted that such reference cannot at law serve as a basis for a 35 U.S.C. § 102 rejection for any of these claims and withdrawal of such ground of rejection is earnestly solicited.

**Claims 10 and 21 as anticipated by Posey**

As discussed above in more detail, it is respectfully submitted that the present § 102(b) rejection of claims 10 and 21 is moot in light of the above amendments and comments. Specifically, the proposed reference, Posey, fails to disclose each and every element of the claimed invention in independent claim 10 and as such cannot serve as a basis for a 35 U.S.C. § 102 rejection for claim 10. As claims 21 depends from and further limits claim 10, it is respectfully submitted that such reference cannot serve as a basis for rejecting claim 21. Withdrawal of such ground of rejection is earnestly solicited.

**35 U.S.C. § 103(a) REJECTIONS****Claims 1, 2, 4, 5, 7-9, 12, and 13 as unpatentable over Jio in view of Bass**

It is respectfully submitted, as above argued, that the presently proposed base reference, Jio, fails to adequately teach each and every element of the claimed invention. Specifically, each of the independent claims specifies the provision of a light-reflective tape (i.e., sticker) adhered to the apparatus.

While Jio fails to teach such an element, the proposed secondary reference, Bass, similarly fails to overcome such shortcoming. The light reflective element of Bass is a rigid plastic element that encompasses “*three-dimensional shapes, such as cubes, pyramids, tetrahedrons, etc., formed or cut, into the plastic material*” to reflect the light. Further, such light-reflective element is “*immovably fastened*” to the clip of Bass.

It is respectfully submitted that the claimed light-reflective tape/sticker of the present invention as described and claimed is a flexible, removable element and furthermore exists only as a substantially two-dimensional surface for reflection of light. As such, the two elements are not proper substitutes for each other and their interactive use as a basis for rejection of claims 1, 2, 4, 5, 7-9, 12, and 13 is improper. Put another way, the presently proposed combination of Jio and Bass teaches away from the invention as presently claimed. Therefore, withdrawal of such grounds of rejection and issuance of a formal Notice of Allowance is earnestly solicited.

**Claims 1, 2, 4, 6, 9, 12, and 13 as unpatentable over Hatayan in view of Bass**

As above argued, it is respectfully submitted that the proposed combination of Hatayan and Bass teaches away from the present invention as claimed due to its failure to teach each and every element of the claimed invention. As in the above discussion of the Hatayan-based §102 rejection of certain claims of the present application, it is submitted that Hatayan fails to teach the light-reflective tape sticker disclosed in each independent claim of the present application. As discussed immediately above, it is not believed that Bass suitably overcomes such shortcoming of Hatayan.

Therefore, it is believed that claims 1, 2, 4, 6, 9, 12, and 13 are all in condition for allowance as amended. Withdrawal of the present ground of rejection and issuance of a formal Notice of Allowance is respectfully requested.

**Claims 3, 14, and 20 as unpatentable over Jio in view of Beebe**

It is respectfully submitted, as above argued, that the presently proposed base reference, Jio, fails to adequately teach each and every element of the claimed invention. Specifically, each of the independent claims specifies the provision of a light-reflective tape (i.e., sticker) adhered to the apparatus.

While Jio fails to teach such an element, the proposed secondary reference, Beebe, similarly fails to overcome such shortcoming. In fact, Beebe is specifically cited to teach a light-reflective paint or dye not a light-reflective tape sticker. As such, it is respectfully submitted that the proposed combination of Jio and Beebe fails to teach each and every element of the claimed invention and

thus cannot properly serve as a § 103 basis for rejecting claims 3, 14, or 20. Withdrawal of such ground of rejection is earnestly solicited.

**Claims 11 and 19 as unpatentable over Jio in view of Ryder**

It is respectfully submitted, as above argued, that the presently proposed base reference, Jio, fails to adequately teach each and every element of the claimed invention. Specifically, each of the independent claims specifies the provision of a light-reflective tape (i.e., sticker) adhered to the apparatus.

While Jio fails to teach such an element, the proposed secondary reference, Ryder, similarly fails to overcome such shortcoming. Ryder is specifically cited to teach an orange pigment as part of the composition of a trail marker so as to make it more visible during day light hours and not a light-reflective tape sticker. As such, it is respectfully submitted that the proposed combination of Jio and Ryder fails to teach each and every element of the claimed invention and thus cannot properly serve as a § 103 basis for rejecting claims 11 or 19. Withdrawal of such ground of rejection is earnestly solicited.

**Claims 22 and 23 as unpatentable over Posey in view of Beebe**

As above-argued, the proposed base reference, Posey, fails to teach a claimed element of the present invention as specified in independent claim 10, from which claims 22 and 23 depend. Only, if the proposed secondary reference, Beebe, teaches such element would the proposed combination be a valid basis for a § 103 rejection. It is respectfully submitted that Beebe similarly fails to teach a

light-reflective tape sticker as claimed in independent claim 10. In fact, the Beebe reference is cited solely for the purpose of teaching a light-reflective paint or dye as used on a trail marker.

It is respectfully submitted that the proposed combination of Posey and Beebe fails to teach each and every claimed element of the present invention and therefore cannot serve as a proper basis for a § 103 rejection of claims 22 and 23. Withdrawal of such ground of rejection and issuance of a formal Notice of Allowance is earnestly solicited.

**Claim 24 as unpatentable over Jio and Bass in view of Ryder**

As argued above, neither of the proposed secondary references teach a light-reflective tape sticker as claimed in the amended claims of the present application. Similarly, as argued above, Jio, fails to teach such an element. Therefore, the proposed combination of references fails to teach each and every claim element identically as claimed and thus cannot serve as a proper basis for a § 103 rejection of claim 24. Withdrawal of such ground of rejection and issuance of a formal Notice of Allowance is respectfully requested.

**CITED RELEVANT PRIOR ART**

It is not believed that any of the prior art cited either by the Examiner or the Applicant, alone or in combination either with each other or other cited prior art teaches, discloses, suggests or makes obvious the claimed features of the present invention.



**CONCLUSION**

In view of the foregoing amendments and comments, Applicants respectfully request withdrawal of all the current grounds of rejection and the drawing objection and the issuance of a formal Notice of Allowance. The Examiner is invited to telephone the undersigned at his convenience should only minor issues remain after consideration of this amendment in order to permit early resolution of the same.

Respectfully submitted,

1/21/05  
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